

REMARKS

Claims 67-90 are pending in the application.

Claims 86-90 have been rejected.

Claims 86 and 90 have been amended.

I. **NONSTATUTORY DOUBLE PATENTING REJECTION**

Claims 67-90 have been provisionally rejected under the judicially created doctrine of double patenting over claims of co-pending Application Serial Nos. 10/662,603 and 10/808,092.

The rejection is respectfully traversed.

The Office Action appears to base the rejection on “anticipation” and asserts that (1) Claims 67 and 68 of the present application include every element of claim 35 of co-pending application 10/662,603, and (2) Claims 67 and 71 of the present application include every element of claim 64 of co-pending application 10/808,092.

Because Claims 67, 68 and 71 of the present application include one or more additional elements than those elements recited in claim 35 (Serial No. 10/662,603) and claim 64 (Serial No. 10/808,092, we assume that the Office Action is asserting that Claims 67-90 in the present application are rejected based upon obviousness-type double patenting.¹

¹ Moreover, Applicant respectfully disagrees that the subject matter claimed in the instant application would be covered by any patent granted on the referenced co-pending applications.

As a result, the Office Action has failed to establish a *prima facie* case that the subject matter of the present Claims 67-90 is obvious over the claims of the co-pending applications. The Office Action merely concludes that since elements recited in the claims of the co-pending application (claim 35, claim 64) may also be recited in the Claims 67, 68 and 71 of the instant application, then the Claims 67, 68, 71 of the present application “anticipate” claims 35 and claim 64 of the co-pending applications. The mere inclusion of similar or same elements recited in pending claims of another co-pending application within claims of the instant application does not provide an appropriate basis for a double patenting rejection of the claims of the instant application, without any further evidence that all the subject matter within the claims of the instant application is obvious over the earlier claims.

Accordingly, the Office Action has failed to establish a *prima facie* case of obviousness-type double patenting, and the Applicant respectfully requests withdrawal of this rejection.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 86-90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood WO 98/18283 in view of Java Telephony API: An Overview (“Java Telephony API”). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis

to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to independent Claims 86 and 90, these claims have been amended to recite, in general terms, that (1) the call server wrapper includes a first interface operable for receiving web application data in a first format over an internet protocol (IP) network from the web application and translating the received web application data into a second format, and a second interface operable for transmitting the translated web application data in the second format over the IP network to the legacy call server, and (2) the telephony device wrapper includes a first interface operable for receiving web application data in a first format over the IP network from the web application and translating the received web application data into a second format, and a second interface operable for transmitting the translated web application data in the second format over the IP network to the legacy telephony device. See, Claims 86 and 90, as amended.

Applicant respectfully submits that the Wood reference and the Java Telephony API reference, either alone or in combination, fails to disclose, teach or suggest a call server wrapper and telephony device wrapper, each with two interfaces, that translates data received over the IP network from the web application from one format (web application format) to another format (call server format or telephony device format, respectively) and transmit the translated data over the IP network to the respective call server or telephony device. See, Applicant's specification, Figure 1 and accompanying text.

Based on the foregoing, independent Claims 86 and 90 are not obvious in view of the combination of Wood with Java Telephony API.²

With respect to independent Claims 87, 88 and 89, the Office Action argues that Java Telephony API teaches using a web application to control a legacy telephone and a telephony device wrapper having a web application program interface and a telephony device interface for enabling the web application to communicate with the telephony device. Applicant submits that the Java Telephony API appears to describe the JTAPI operating on a network computer that interfaces with other Java applications also residing on the network computer. Java Telephony API, page 4. Thus, the JTAPI does not appear to interface with a web application on a web server located across an IP network. Therefore, the Wood-Java Telephony API combination does not disclose, teach or suggest each and every element of the claims.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 86-90.

² Applicant further submits that there is no motivation or suggestion to combine Java Telephony API (JTAPI) with Wood. The Office Action argues that Wood teaches using JTAPI, however, Wood teaches using JTT (Java Telephony Toolkit) not JTAPI. See, Wood, page 5, lines 1-11. In addition, Wood teaches that the JTT protocol is used with the interface between the telephone switch 16 and the web facility 22, not for use between the web application and the legacy telephone, as recited by the Applicant.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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